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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,681	04/16/2004	Cesur Celik	7012-X04-002	9588

27317 7590 09/16/2005

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MIAMI, FL 33180

EXAMINER

MAI, NGOCLAN THI

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/826,681

Applicant(s)

CELIK ET AL.

Examiner

Ngoclan T. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/7/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) 8-11, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 12, 14 and 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/25/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-12, 14 and 16-20 are pending. Claims 8-11 and 16-17 are withdrawn from consideration as being drawn to non-elected species.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 12, 14, and 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Akimoto et al. (U.S. Patent No. 6,530,972 B2).

Akimoto et al disclose the claimed base metal alloy powder comprising Ni and Cu and having Ni:Cu weight ratio of 7:3, i.e. 70 wt% Ni and 30 wt% Cu, wherein the alloy powder comprises particles having average particle size of 0.6 micron (600 nm) and are spherical in shape, see Table 1, Example 7.

As for claims 18-19 while Akimoto et al do not teach the temperatures at which onset oxidation occurs, however, it appears the claimed property is material property. Consequently, the property as recited in the instant claims would have inherently possessed by the teachings of the cited reference. Therefore, the burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possesses characteristics attributed to the claimed product. In re Spade, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990), In re Best, 195 USPQ 430 and MPEP § 2112.01.

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Regarding claim 20 Akimoto et al disclose the claimed limitation where the powder is used in a conductor paste for an internal conductor of a multilayer capacitor, col. 6, lines 6-12.

Claim Rejections - 35 USC § 103

5. Claims 2 - 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akimoto et al in view of Igarashi JP411067588 (English translation).

Akimoto et al disclose the alloy powder for used as internal electrode substantially as claimed. The difference between the claims and Akimoto et al is that Akimoto et al do not specifically teach adding at least one other element cited in the claims.

Igarashi discloses a method for making electronic component wherein auxiliary components can be added to a main component of the electroconductive material for internal electrode to increase the resistivity and ease of the control the resistance value, see paragraphs [0009], [0010], [0011], [0012]. The auxiliary components employed can be one or more selected from P, Cr, Fe, Al, Si, Co, W, Mn, Sn, Mo and B and can be added to 99.9-70 w% Ni-Cu alloy in the amount of from 0.01 to 30 wt% of the total amount of the electroconductive material, [0013] [0014].

It would have been obvious to one of ordinary skill in the art at the time the invention was made that the base metal alloy powder taught by Akimoto et al includes at least one of the auxiliary component in the amount taught by Igarashi because such addition would not only increase the resistance value of the electronic component but also facilitate the control of the resistance value as taught by Igarashi.

Regarding claim 4, Akimoto et al in view of Igarashi do not specifically teach adding auxiliary component in the amount as claimed, however determination of an optimum or preferred amount of auxiliary to be added to obtain desired result is within the level of one skilled in the art and would have been obvious. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable range by routine experimentation." See *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955); *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA

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1969); *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d (Fed.cir), cert. denied, 493 U.S. 975 (1989); *In re Kulling*, 897 F.2d 1147, 14 USPQ2d 1056 (Fed. Cir. 1990); and *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997). Furthermore, the specification contains no disclosure of either the critical nature of the claimed amount range or any unexpected results arising therefrom.

Where patentability is said to be based upon particular chosen amount or upon another variable recited in the claim, the applicant must show that the chosen dimensions are critical. *In re Woodruff*, 919 F.2d, 1575, 1578, 16 USPQ2d, 1936 (Fed. Cir. 1990).

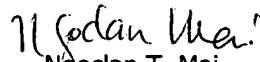
Regarding claims 5 to 7, while Akimoto et al in view of Igarashi do not specifically teach Cr in the base alloy powder it would have been obvious to one of ordinary skill in the art to select any portion of range, including the claimed Cr, from the broader range disclosed in Igarashi's reference because the Igarashi's reference finds that the auxiliary component in the entire disclosed range can be added to the electroconductive material for the purposes discussed above in making electronic component. --- Note: Even if a reference teaches a preferred range within a broader range, it still does not "teach away" from the claimed invention. See MPEP 2123.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoclan T. Mai whose telephone number is (571) 272-1246. The examiner can normally be reached on 9:30-6:00 PM Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ngoclan T. Mai
Primary Examiner
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n.m .